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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,705	12/13/2004	Hirofumi Masuda	1600-0157PUS1	9097
2292	7590	04/19/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			BERNSHTEYN, MICHAEL	
			ART UNIT	PAPER NUMBER

1713

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/517,705	Applicant(s) MASUDA ET AL.	
	Examiner Michael Bernshteyn	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 10-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Applicant's election with traverse of Group I, claims 1-9 in the reply filed on February 3, 2006 is acknowledged. The traversal is on the ground(s) that according to MPEP 1850(III)(C), no lack of unity exists between groups of claims. This is not found persuasive because the cited passage applies to PCT practice. The present Application is a 372 (national stage) of PCT/JP03/07472. In this case according US practice, the restriction is proper because of the reasons set forth in the previous Office Action, namely, the inventions of Groups I and II are related as intermediate and final product, and they have different chemical structures. Therefore, they are patently distinct.

The requirement is still deemed proper and is therefore made FINAL.

This office Action is in response to the Amendment filed on February 3, 2006. Claims 1-9 are now pending; claims 1-9 and 16 have been amended. In view of the Amendment, claim objection is withdrawn, and claim rejections under 35 USC § 103 are maintained.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35 U.S.C. not included in this Action can be found in a prior Office Action.
3. Claims 1-9 are rejected under 35 U.S.C. § 103(a) as obvious over Moriyama et al. (U.S. Patent Application Publication 2001/0005742) in view of Piloni et al. (U.S. Patent 3,196,133) for the rationale recited in paragraph 8 of Office Action dated on September 29, 2005.

Response to Arguments

4. Applicants' arguments filed February 3, 2006 have been fully considered but they are not persuasive.
5. Apparently, Applicants' focal arguments recite in the contention that:
 1. the combination of references is improper because it is improper to combine references which are in separate fields of endeavor;
 2. the unexpected result shown in example 4 overcomes 103(a) obviousness.
6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
8. In response to applicant's argument that Piloni's reference is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the

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applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

9. Concerning the first argument, Applicants contend that Moriyama et al. teach that the rubbery acrylic elastomer is useful in the field of a sealing materials such as gaskets, oil seal, 'O' rings or in the field of hose materials. This is in distinction to Piloni et al. wherein the composition is taught to be useful in the field of coatings, paints, lacquers, inks, adhesives **and the like** (col. 1, lines 40-44). Accordingly, the skilled artisan would not be motivated to look to the teaching of Piloni et al. to modify the acrylic elastomer of Moriyama et al. since the vinyl chloride resin of Piloni et al. is not taught to be used in the same field of endeavor as the acrylic elastomer of Moriyama et al. (pages 17-18).

It is worth to mention that Piloni's polymer comprises instantly claimed components A of the claimed acrylic rubber besides vinyl chloride, which is readable in claim 1 in view of terminology "comprised of".

Furthermore, the utility of Piloni's polymer besides coating it can also be used for other purposes because they have good adhesiveness and flexibility (col. 16, line 70 through col. 17, line 2), which may used very well as the materials for gaskets, oil seal, etc. as taught by Moriyama.

At last, since ample motivation has been provided to establish *prima facie* case of obviousness, 103(a) rejection still sustains.

10. Concerning the second argument, Applicants contend that even assuming *arguendo* that the combination of Moriyama et al. and Piloni et al. make the present invention *prima facie* obvious (which it does not), the *prima facie* case would be overcome by the unexpectedly superior properties associated with the inventive acrylic rubber (page 19, 2nd paragraph).

As to the unexpected result is concerned, it is noted that monocyclohexyl maleate was used in the inventive example 4 rather than mono-n-butyl maleate used in comparative example 3 (acrylic rubber "F"). However, the showing of the unexpected result is not commensurate in scope with the claim. Since claim 1 recites **any alicyclic structure** which include **numerous species** as shown in pages 4-5 of specification, it is the examiner position that whether the same unexpected result in terms of Mooney scorch time, extrusion processability, dry physical properties, heat resistance and permanent set (page 20) can be extrapolated to other species above mentioned.

11. Therefore, in view of the discussion above, the rejection of record has not been withdrawn.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-F 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Bernshteyn
Patent Examiner
Art Unit 1713

MB
04/12/2006


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